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THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Ex parte MICHAEL F. GRIFFIN and JAMES L. PAJAN JUN 26 1997

Appeal No. 95-4631
Application No. 08/227,151¹

PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF²

Before LYDDANE, MEISTER, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 11 through 18 and 21 through 31, which are all of the claims pending in this application.³

We REVERSE.

¹ Application for patent filed April 13, 1994. According to the appellants, the application is a division of Application No. 07/666,988, filed March 11, 1991, which is now abandoned.

² We note that the appellants did not attend the hearing scheduled for June 9, 1997.

³ Subsequent to the final rejection claims 11, 21 and 25 were amended.

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BACKGROUND

The appellants' invention relates to a method of preventing wicking of paint utilizing a magnetic masking member. Claim 21 is representative of the subject matter on appeal and a copy of claim 21, as it appears in the appellants' brief, is attached to this decision.

The prior art reference of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 is: "Sign of the Times" (Times), pp. 74-76, September 1971

In addition to the foregoing reference, the examiner has also relied upon the admission of prior art discussed on pages 1-2 of the appellants' specification.

Claims 11 through 16, 21 through 26 and 29 through 31 stand rejected under 35 U.S.C. § 103 as being unpatentable over the admitted prior art combined with The Times reference.

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Claims 15, 22, 27⁴ and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over The Times reference in view of the admitted prior art.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the § 103 rejections, we make reference to the examiner's answer (Paper No. 12, mailed April 13, 1995) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 11, filed March 2, 1995) and response to the examiner's answer (Paper No. 13, filed May 17 1995) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

⁴ We note that claim 27 was included in this rejection in the final rejection (Paper No. 7, mailed December 9, 1994) but was not included in the statement of this rejection in the examiner's answer (Paper No. 12, mailed April 13, 1995). We view this omission as an inadvertent oversight and will treat claim 27 as still being subject to this rejection.

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With regard to the 35 U.S.C. § 103 rejection of claims 11 through 16, 21 through 26 and 29 through 31 as being unpatentable over the admitted prior art combined with The Times reference, the examiner concluded that it would have been an obvious expedient to the skilled artisan to use flexible magnetic sheeting (tape) of the type disclosed by The Times reference in place of the adhesive masking tape used in the prior art for masking a selected ferromagnetic surface (area) of an object to protect that surface from being painted during a painting operation. We do not agree.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that

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individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). This the examiner has not done. The examiner points to nothing in the cited Times reference or the admitted prior art, either alone or in combination, suggesting or teaching appellants' claimed invention.

The admitted prior art teaches covering the machined face of brake heads with adhesive masking tape to keep the machined face of the brake head free of any paint. The admission indicates that a workman covered the entire machined face by repeatedly and randomly placing strips of adhesive masking tape in overlapping fashion. After the surface was completely covered, the masking tape was hand-trimmed to remove the excess masking tape to define a precise delineation for painting. Following the painting and the drying of the paint, the masking tape was manually peeled off. Thereafter, the machined face was cleaned to remove any adhesive, masking tape, or paint therefrom.⁵

⁵ See page 1, line 13 to page 2, line 20 of the specification.

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The Times reference teaches the use of a flexible magnetic sheet/tape adhered to a ferromagnetic surface by means of magnetic material embedded in the flexible sheet/tape.

We agree with the appellants that the applied prior art fails to provide the needed suggestion or motivation to one of ordinary skill in the art at the time of the appellants' invention to modify the applied prior art in the manner proposed by the examiner. In that regard, the admitted prior art provides no suggestion or motivation to replace the adhesive masking tape with a magnetic masking tape and the Times reference provides no suggestion or motivation for using magnetic sheet/tape for masking a surface being painted.⁶ The Times reference and the admitted prior art disclose, at most, that one skilled in the art might find it obvious to try using magnetic tape as a masking tape. But whether a particular combination might be "obvious to try" is not a legitimate test of patentability. In re Fine, 837 F.2d at 1075, 5 USPQ2d at 1599.

⁶ We view the method claims under appeal in this application to be of significantly different subject matter than the apparatus claims appealed in Application No. 07/666,988, in which similar rejections were made by a different panel of this Board under the provisions of 37 CFR 1.196(b).

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Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Says., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And "teachings of references can be combined only if there is some suggestion or incentive to do so." Id. Here, the prior art contains none. In fact, the advantages of utilizing a magnetic masking member are not appreciated by the prior art applied by the examiner.

Instead, it appears to us that the examiner relied on hindsight in reaching his obviousness determination. However, our reviewing court has said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). It

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is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." Id. Since the limitation that a magnetic masking member be used to cover a given area of a magnetic object to be painted is not taught or suggested by the applied prior art, we will not sustain the 35 U.S.C. § 103 rejection of independent claims 11, 21 and 25, and of dependent claims 12 through 16, 22 through 24, 26 and 29 through 31.

Furthermore, we agree with the appellants that the prior art applied by the examiner does not teach or suggest the following limitations: (1) cutting the magnetic masking member to conform to the machined brake shoe receiving surface as recited in claims 11 and 25, (2) cleaning the magnetic masking member as recited in claims 12 and 26, and (3) removing excess paint as recited in claims 23 and 29.

We have also reviewed the rejection of claims 15, 22, 27 and 28 which stand rejected under 35 U.S.C. § 103 as being unpatentable over the Times reference in view of the admitted

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prior art but find nothing therein which makes up for the deficiencies of the admitted prior art and the Times reference" discussed above. Accordingly, we cannot sustain the examiner's rejection of appealed claims 15, 22, 27 and 28 under 35 U.S.C. § 103.

Finally, in view of the fact that we will not sustain any of the examiner's rejections since the applied prior art does not suggest all the limitations of the claims on appeal, this panel of the Board did not reach the issue of whether or not the Times reference is analogous art. However, we wish to point out to the examiner that, contrary to his view expressed on page 6 of the answer, the burden is on the examiner to adequately demonstrate that the Times reference is analogous art, not on the appellants to adequately demonstrate that it is non-analogous art.

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APPENDIX

21. A method of preventing wicking of paint while protecting a given area of a magnetic object from being painted during a painting operation, comprising the steps of:

- (a) covering the given area of the magnetic object with a magnetic masking member which is magnetically attracted to the given area of the magnetic object with sufficient force to prevent wicking of paint;
- (b) painting the magnetic object as well as the magnetic masking member;
- (c) permitting the paint to dry;
- (d) removing the magnetic masking member from the given area of the magnetic object so that steps (a), (b), and (c) may be repeated.